

49, 50, 52-55, 57-61, 63, 65, 67-72, and 77 are subject to examination and have been rejected.

**II. Rejection under § 103(a)**

The Examiner rejects claims 1-8, 10-13, 21, 39-45, 49, 50, 52-55, 57-61, 63, 65, 67-72, and 77 under 35 U.S.C. § 103(a) as unpatentable over Arnaud et al. (U.S. Patent No. 5,961,998) ("*Arnaud*") in view of Kantner et al. (U.S. Patent No. 6,433,073) ("*Kantner*"). Office Action, page 2. Specifically, the Examiner alleges that *Arnaud* discloses a lipstick with pigments (col. 4, lines 63-64) and parleam (col. 5, line 45). *Id.* The Examiner further alleges that *Kantner* "teaches a polyurethane dispersion useful in cosmetics such as lipsticks for forming hydrophobic films" (citing the title, col. 5, lines 29-36). *Id.* Therefore, the Examiner concludes that it would have been obvious for one of ordinary skill in the art to use the dispersion of *Kantner* in the lipstick of *Arnaud* "for the beneficial effect of forming a hydrophobic film with a lipstick." *Id.* at page 3. Applicants respectfully disagree and traverse this rejection for at least the following reasons.

To establish a *prima facie* case of obviousness, three basic criteria must be met, including that (1) there must be some suggestion or motivation, either in the references or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the references, and (2) there must be a reasonable expectation of success for the modification or combination. M.P.E.P. § 2143. "Both the suggestion and the reasonable expectation of success must be found in the prior art reference, not in the applicant's disclosure." *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991).

First, the Examiner has failed to point to any evidence of a suggestion or motivation to use the dispersion of *Kantner* in the lipstick of *Arnaud* to arrive at the presently claimed invention.

*Kantner* discloses “a stable polyurethane dispersion in [an] alcohol-water system.” Col. 1, lines 6-7 (emphasis added). *Kantner* further teaches that “[s]table polyurethane dispersions in hydro-alcohol (i.e., alcohol-water) systems are especially difficult [to form].” Col. 1, lines 39-65 (emphasis added). Therefore, contrary to the Examiner’s allegation, one of ordinary skill in the art would not have been motivated to combine *Kantner*’s polyurethane dispersion in an alcohol-water system, which is already stable, with *Arnaud*’s composition, as such an alleged combination might destroy the already-existing and desired stability of *Kantner*’s dispersion.

The sole reason alleged by the Examiner in support of his assertion that it would be obvious to use the dispersion of *Kantner* in the lipstick of *Arnaud* is “for the beneficial effect of forming a hydrophobic film.” Office Action, page 3. However, as clearly indicated in *Kantner*, and admitted by the Examiner, it is the stable polyurethane dispersion in the alcohol-water systems disclosed in *Kantner* that has the ability to form hydrophobic films. See col. 5, lines 29-30 and Office Action, page 2. If the stability of the polyurethane dispersion in an alcohol-water system is destroyed by combining it with *Arnaud*’s composition, the beneficial effect of forming hydrophobic films might not be achieved.

*Arnaud* discloses a cosmetic composition comprising (1) a liquid fatty phase comprising at least one aromatic group-containing oil, (2) a particulate phase, and (3) a thickening agent for the fatty phase. Abstract; col. 1, line 66 - col. 2, line 3. *Arnaud*

further discloses that the "liquid fatty phase contains one or more types of oil other than the oils containing an aromatic group" chosen from hydrocarbon-based, silicone-based, and fluoro oils. Col. 5, lines 21-25.

Therefore, solely for purposes of argument, even if one were to combine the polyurethane dispersion in an alcohol-water system disclosed in *Kantner* with *Arnaud's* composition, there is no evidence of any suggestion or motivation to pick and choose the hydrocarbon-based oils over the silicone-based and fluoro oils, which are equally disclosed in *Arnaud*, to arrive at the presently claimed invention.

Additionally, the Examiner has failed to point to any evidence of a reasonable expectation of success in using the dispersion of *Kantner* in the lipstick of *Arnaud* to form "the at least one continuous liquid fatty phase containing at least one hydrocarbon-based oil and structured with at least one polymer . . . said at least one polymer being soluble or dispersible in said at least one hydrocarbon-based oil" as recited in, for example, claim 1 of the present invention. The Examiner relies on *Arnaud* for its teaching of parleam (an example of the at least one hydrocarbon-based oil) and on *Kantner* for its teaching of polyurethane (an example of the at least one polymer). However, as discussed above, the teaching of the polyurethane in *Kantner* is limited to the stable dispersion in its alcohol-water system, which is difficult to form. Therefore, the Examiner has not met his burden of proving the existence of a reasonable expectation of success to form "the at least one continuous liquid fatty phase containing at least one hydrocarbon-based oil and structured with at least one polymer . . . said at least one polymer being soluble or dispersible in said at least one hydrocarbon-based

oil" as recited in, for example, claim 1 of the present invention, by using the dispersion of *Kantner* in the lipstick of *Arnaud*.

Accordingly, as the Examiner has failed to establish a *prima facie* case of obviousness, Applicants respectfully request this rejection be withdrawn.

### III. Conclusion

In view of the foregoing remarks, Applicants respectfully request reconsideration of this application, and the timely allowance of the pending claims.

If the Examiner believes a telephone conference would be useful in resolving any outstanding issues, he is invited to call Applicants' undersigned representative at (202) 408-4218.

If there is any fee due in connection with the filing of this response, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

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